



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,095	11/20/2003	Brent David Franklin	AUS920030935US1	9423
35525	7590	07/24/2008		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380				
EXAMINER				
JOSEPH, TONYA S				
ART UNIT		PAPER NUMBER		
3628				
NOTIFICATION DATE		DELIVERY MODE		
07/24/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeciipaw.com

### Office Action Summary

**Application No.**

10/718,095

**Applicant(s)**

FRANKLIN, BRENT DAVID

**Examiner**

TONYA JOSEPH

**Art Unit**

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

Claims 6-8 and 14-18 have been previously examined. Claims 6-8 and 14-18 have been cancelled. Claims 19-29 have been added. Thus claims 19-29 are presented for Examination.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 04/21/2008 has been entered.

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 19-29 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered

Art Unit: 3628

consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 19-29 been renumbered 23-33.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 23-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown U.S. Patent No. 6, 618, 062 in view of Cogen U.S. Pre-Grant Publication No. 2002/0138350 A1 in further view of Ukeda U.S. Pre-Grant Publication No. 20040068631.

6. As per Claims 23, 30 and 33, Brown teaches detecting, by a data processing system, a portable storage device associated with a customer (see Col. 7 lines 22-23 and Col. 12 lines 9-15), wherein the portable storage device comprises a first set of dining preferences for a first restaurant in a set of restaurants and a second set of dining preference for a second restaurant in the set of restaurants (see Col. 5 lines 6-19), wherein the first set of dining preferences comprises a first selection of food items and food preparation preferences associated with the first restaurant, wherein the second set of dining preferences comprises a second selection of food items and food preparation preferences (see Col. 5 lines 6-19, 30-44 and Col. 9 lines 41-54), wherein the

first set of dining preferences and the second set of dining preferences are stored in a memory of the portable storage device (see Col. 6 lines 60-67 and Col. 7 lines 1-8); reading, by the data processing system, the first set of dining preferences from the portable storage device (see Col. 7 lines 23-24 and Col. 12 lines 9-12);

displaying the first set of dining preferences, on a display in the first restaurant, for order verification (see Col. 12 lines 35-48), wherein the second set of dining preferences stored on the portable storage device are not displayed (see Col. 12 lines 15-21);

responsive to receiving a verified first set of dining preferences, generating a food order using the first set of dining preference (see Col. 12 lines 40-50 and Col. 6 lines 45-59); and

storing the first set of dining preferences in the memory of the portable storage device and on an order system in the first restaurant (see Col. 6 lines 60-67 and Col. 7 lines 1-12). Brown does not explicitly teach the method taught by Cogen a portable device with preferences for different and unrelated restaurants and storing information regarding restaurants by restaurant name (see para. 55). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Brown to include the teachings of Cogen to provide a service for various types of restaurants and to organize data. Brown in view of Cogen does not explicitly teach the method taught by Ukeda storing information in response to receiving a personal identification certificate (see para. 10). It would have been prima facie obvious to one of ordinary skill in the art at

the time of invention to modify the methods of Brown and Cogen to include the teachings of Ukeda to authenticate information as taught by Ukeda para. 10.

7. As per Claim 24, Brown in view of Cogen in further view of Ukeda teaches the method of claim 19 as described above. Brown further teaches wherein the portable storage device comprises a processor and a communications interface (see Col. 4 lines 35-48; 61-65; Col. 5 lines 1-5 and Fig. 2).

8. As per Claim 25, Brown in view of Cogen in further view of Ukeda teaches the method of claim 20 as described above. Brown further teaches wherein the communication interface allows for communication with the first restaurant (see Col. 12 lines 9-21) and writing the first set of dining preferences to the portable storage device using the communications interface (see Col. 5 lines 1-19; 19-26; Col. 8 lines 34-42 and Figs 1-2).

9. As per Claim 26, Brown in view of Cogen in further view of Ukeda teaches the method of claim 20 as described above. Brown further teaches wherein the communication interface allows for communication with the second restaurant and writing the second set of dining preferences to the portable storage device using the communications interface (see Col. 5 lines 1-19; 19-26; Col. 8 lines 34-42 and Figs 1-2).

10. As per Claims 27 and 31, Brown in view of Cogen in further view of Ukeda teaches the method of claims 19 and 26 as described above. Brown further teaches responsive to a customer indicating modifications to the first set of dining preferences, receiving the modifications (see Col. 10 lines 27-60 and Fig. 7);

Art Unit: 3628

updating the first set of dining preferences to form an updated first set of dining preferences (see Col. 10 lines 39-60 and Fig. 7);

11. As per Claim 28, Brown in view of Cogen in further view of Ukeda teaches the method of claim 20 as described above. Brown further teaches wherein the updated first set of dining preferences are stored in the memory of the portable storage device and the order system (see Col. 10 lines 27-31; 47-54; and Col. 6 lines 60-67).

12. As per Claims 29 and 32, Brown in view of Cogen in further view of Ukeda teaches the method of claims 20 and 27 as described above. Brown further teaches wherein the food order is generated using the updated first set of dining preferences (see Fig. 7-8).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TONYA JOSEPH whose telephone number is (571)270-1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tonya Joseph  
Examiner  
Art Unit 3628

/JOHN W HAYES/  
Supervisory Patent Examiner, Art Unit 3628